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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,412	03/30/2001	Eleanor S. Wilson	85SF-00110	3204

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EXAMINER
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COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3694

MAIL DATE	DELIVERY MODE
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11/01/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/681,412

Applicant(s)

WILSON ET AL.

Examiner

Ella Colbert

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 45-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 45-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-20 and 45-53 are pending. Claims 1-3, 11-13, and 45-47 have been amended in this communication filed 7/31/07 entered as Response After Non-Final Action.
2. The 35 USC 112, second paragraph rejections have been overcome by Applicant's amendment to claims 1-3, 11-13, 45, and 47 and are hereby withdrawn from the prior Office Action. However, there are still remaining 35 USC 112, second paragraph issues remaining as set forth here below.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1, 11, and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites "a financing requirement it is unclear from the claim limitation what applicant's "financing requirement" entails and what the requirement is from the claim language. Claims 11 and 45 have a similar problem.  
  
Claim 11, also recites "...related to a financing requirement". This claim limitation should recite "... related to at least one financing requirement". In order to be in agreement with claims 1 and 45.

Art Unit: 3694

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim 1, also recites “analyzing the information ...; and recommending to the customer ...”. It is unclear and vague who or what is analyzing the information and doing the recommending to the customer ...”. Is the potential lender for the loan or the computer performing these steps? Claims 11 and 45 have a similar problem.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7, 11-17, 45-48 rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,940,812) Tengel Et al, hereafter Tengel.

Claims 1, 11, and 45. Tengel discloses, A method for operating a computer to facilitate a choice of a financing product, said method comprising the steps of: prompting a customer to provide information related to a financing requirement (col. 7, lines 1-5, col. 8, line 37-col. 9, line 22, fig. 4 and fig. 5); prompting the customer to input into the computer information describing the energy-related asset being financed, wherein the energy –related asset including at least one of a power generating facility, a refinery, a mine, and a pipeline (col. 8, line 37-col. 9, line 22, fig. 4 –“no. 14 other unique attribute” and fig. 5); prompting the customer to input the computer responses to a

Art Unit: 3694

plurality of questions regarding the at least one requirement for financing the energy-related asset; analyzing the information inputted into the computer by the customer (col. 9, lines 11-54); recommending to the customer based on the analyzed information a type of financing for financing the energy related asset, wherein the financing types include a financing project, a high yield debt, leasing, a project common equity, a limited partnership, a private equity and a preferred equity (col. 9, line 55-col. 10, line 56 and Fig. 6-other unique attributes). Tengal did not expressly disclose the "a power generating facility, a refinery, a mine, and a pipeline, a financing project, a high yield debt, leasing, a project common equity, a limited partnership, a private equity and a preferred equity". However, these are a design choice and simply attributes as well as being non-functional descriptive claim language. Nonfunctional descriptive claim language is not accorded patentable weight.

Claims 11 and 45 are rejected for the similar rationale as given above for claim 1.

Claims 2, 12, and 46. Tengal discloses, further comprising the step of evaluating by the computer a financing type selected by the customer; and determining whether the selected financing type is the recommended financing type (col. 9, line 32- col. 10, line 56).

7. Claims 3-10, 13-20, 47-53 rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,940,812) Tengal et al, hereafter Tengal in view of US 7,177,834) Maestle.

Claims 3, 13, and 47. Tengal failed to disclose, evaluating by the computer a financing type selected by the customer including a project common equity; accessing

Art Unit: 3694

an equity valuation tool when the customer inputs project common equity as the financing type; calculating and equity valuation using the equity valuation tool and information inputted by the customer, wherein the calculated equity valuation relates to the energy-related asset. Maestle discloses, evaluating by the computer a financing type selected by the customer including a project common equity (col. 55, lines 8-43); accessing an equity valuation tool when the customer inputs project common equity as the financing type (col. 56, lines 5-67); calculating and equity valuation using the equity valuation tool and information inputted by the customer, wherein the calculated equity valuation relates to the energy-related asset (col. 57, line 1-col. 58, line 53). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Maestle in Tengal because such a combination would allow Tengal to have a financial model specifically for the project being prepared.

Claims 4, 14, and 48, Tengal failed to disclose, a project common equity financing type selection, prompting the customer to provide describing the energy-related asset including an energy output of the asset. Maestle discloses, a project common equity financing type selection, prompting the customer to provide describing the energy-related asset including an energy output of the asset (col. 91, line 23-col. 92, line 65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Maestle in Tengal because such a modification would allow Tengal to give the age of the property, the location of the property, the condition of the property and the purchase price of the property in order to

be provided a loan to purchase the property and to use the property as collateral for the loan.

Claims 5 and 15. Tengal failed to disclose, wherein the energy-related asset is a power generation plant, the information provided by the customer describing the energy-related asset includes power plant information, current financing information, projected electricity prices. Maestle discloses, wherein the energy-related asset is a power generation plant, the information provided by the customer describing the energy-related asset includes power plant information, current financing information, projected electricity prices (col. 93, line 40-col. 97, line 50). A power plant is a design choice. The current financing information provided by the customer describing the energy related asset including power plant information, current financing information, and projected electricity prices can be for anything. For example, a loan for a car or a home or a warehouse or a commercial property.

Claims 6, 16, and 50. Tengal failed to disclose, wherein default values are available for at least one of projected electricity prices and projected fuel costs, when specific values are not provided. Maestle discloses, wherein default values are available for at least one of projected electricity prices and projected fuel costs, when specific values are not provided (col. 103, line 1-col. 109, line 65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Maestle in Tengal because such a combination would allow Tengal to have set default values when an estimate is being made and the specific costs are not known or accessible.

Claims 7 and 17. Tengal discloses, further comprising the step of displaying a computer generated screen describing a selected financing type (col. 4, lines 41-45 and col. 5, lines 20-28).

Claims 8, 18, and 51. Tengal discloses, wherein prompting the customer to input responses comprises the steps of: displaying a computer generated screen listing a plurality of background questions relating to the financing requirement; and displaying a computer generated screen listing a plurality of financing specific questions (col. 4, line 53-col. 5, line 2, col. 8, lines 50-65, and col. 9, lines 12-31).

Claims 9, 19, and 52. Tengal failed to disclose, wherein the background questions relating to the financing requirement comprise at least one of the country where financing is required, which energy related business is the financing for, is the financing required for an operating asset, are U.S. taxes currently being paid by the customer, is the customer interested in either of off-balance sheet or non-recourse financing, and is the customer interested in structured debt such as high yield debt or subordinated debt. Maestle discloses, wherein the background questions relating to the financing requirement comprise at least one of the country where financing is required, which energy related business is the financing for, is the financing required for an operating asset, are U.S. taxes currently being paid by the customer, is the customer interested in either of off-balance sheet or non-recourse financing, and is the customer interested in structured debt such as high yield debt or subordinated debt (col. 14, line 6-col. 26, line 61). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Maestle in Tengal



Art Unit: 3694

because such a combination would allow Tengel to have a financial model specifically for the project being prepared.

Claims 10, 20, 53. Tengel failed to disclose, wherein the financing specific questions comprise at least one of amount of financing, selling or optimizing equity position, willing to share control, upside potential and residuals of the asset, willing to subordinate equity distribution to a preferred equity investor, willing to be contacted regarding the financing, early stage pre-lpo company or company in early stage of corporate cycle and interested in financing senior to common equity but junior to lenders and trade creditors. Maestle discloses, wherein the financing specific questions comprise at least one of amount of financing, selling or optimizing equity position, willing to share control, upside potential and residuals of the asset, willing to subordinate equity distribution to a preferred equity investor, willing to be contacted regarding the financing, early stage pre-lpo company or company in early stage of corporate cycle and interested in financing senior to common equity but junior to lenders and regarding the financing, early stage pre-lpo company or company in early stage of corporate cycle and interested in financing senior to common equity but junior to lenders and trade creditors (col. 110, lines 43-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Maestle in Tengel because such a combination would allow Tengel to have a financial model specifically for the project being prepared.

Claim 49. Tengel and Maestle failed to disclose, Apparatus according to Claim 48 wherein the energy-related asset comprises a power generating facility, and the

information provided by the customer describing the energy-related asset includes plant size, a heat rate, a percentage of revenues under contract, a number of years remaining under contract, a remaining term of the existing debt, an outstanding principal, interest rate, electricity prices and an annual rate of increase, and projections of prices and projected fuel costs including an escalator. The claim limitation of this claim contains nonfunctional descriptive claim language and is therefore not accorded patentable weight.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-20 and 45-53 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Goerz, Jr. et al (US 2002/0065671) disclosed a project customized business to business development with a project development Website.

Ratteree et al (US 2002/0010563) disclosed an industrial process for achieving increased productivity.

### ***Inquiries***


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Wednesday, and Thursday, 5:30AM-3:00PM.

Art Unit: 3694

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

October 24, 2007

  
ZELLA COLBERT  
PRIMARY EXAMINER